

REMARKS

Claims 7, 9, 11, 14-18, 20 and 21 are pending in the application. Claims 13 and 19 are canceled as being directed to a non-elected invention. Claims 7, 9, 11, 14-18, 20 and 21 are under examination and are currently rejected.

Claim 7 has been amended to incorporate the recitations of both of dependent claims 12 and 14 and of dependent claim 10. Claims 12 and 14 have been amended to delete recitations that would be redundant in view of the incorporation of the recitations into claim 7. Claim 10 has been canceled as not further limiting amended claim 7. Claim 7 has also been amended to delete the alternative recitation of "prevention."

Claim 9 has been amended to incorporate the recitations of both of dependent claims 18 and 20, except that E^c is defined as benzene optionally having substituent(s), piperidine optionally having substituent(s), isoxazole optionally having substituent(s), pyrazole optionally having substituent(s), pyridine optionally having substituent(s), thiazole optionally having substituent(s), imidazole optionally having substituent(s), pyrrole optionally having substituent(s), or pyrrolidine optionally having substituent(s) (paragraph bridging pages 20 and 21 of the specification) and G^c is defined as a bond. Claims 18 and 20 have been amended to delete recitations that would be redundant in view of the incorporation of the recitations into claim 9. Claims 9, 18 and 20 have also been editorially amended to recite a pharmaceutical composition, rather than a remedy or preventive.

Claim 15 has been amended to recite the administration is to a mammal, as in claim 7.

Claims 16 and 17 have been amended to recite a pharmaceutical composition rather than a remedy or preventive.

New claim 21 is supported by the descriptions at pages 42, 54 and 55.

A. Claim Rejections - 35 U.S.C. § 112

1. At pages 2-4 of the Office Action, claims 7, 9-12, 14-18, and 20 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Specifically, the Examiner contends that the application as filed does not describe the structure of a representative number of EDG-2 antagonists, as would be required for the claims to recite the entire genus of EDG-2 antagonists.

This rejection has been overcome by amending claims 7 and 9 to recite the compounds of formulas I and III.

While the Examiner has also rejected claims 12, 14, 18 and 20 (reciting formulas I and III) as not complying with the written description requirement, Applicant submits that the EDG-2 antagonists being defined by formulas (I) and (III), are sufficient to demonstrate possession of the invention as claimed.

In view of the above, the Examiner is requested, respectfully, to reconsider and remove this rejection.

2. At pages 4-7 of the Office Action, claims 7 and 9-12, 14-18, and 20 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Specifically, the Examiner contends that the claims are directed to a large genus of chronic conditions as well as to a broad genus of chemical compounds. The Examiner contends that the specification does not enable one of skill in the art to practice the full breadth of the claims without undue experimentation.

In addition to amending independent method claim 7 to recite compounds having a specific chemical formula, claim 7 has been amended to recite the specific chronic conditions recited in claim 10. Method claim 7 has also been amended to remove the recitation of prevention of disease.

Further, composition claim 9 has been amended to delete the recitation of intended use.

In view of the above, the Examiner is requested, respectfully, to reconsider and remove this rejection.

3. At pages 7 and 8 of the Office Action, claims 14, 15 and 20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

(a) The Examiner contends that the term “acidic group” renders claims 14 and 20 indefinite, because it is not connected with a particular structure.

This rejection is traversed, respectfully. One of skill in the art can readily determine whether any particular group is an “acidic group.” Thus, the metes and bounds of the claim are clear. The Examiner is reminded that breadth of a limitation is not the same as indefiniteness.

(b) The Examiner contends that the language “wherein one or more selected from” renders claim 15 indefinite.

Claim 15 has been amended to clarify this language.

In view of the above, the Examiner is requested, respectfully, to reconsider and remove this rejection.

B. Claim Rejections - 35 U.S.C. § 102

1. At page 8 of the Office Action, claims 9 and 16 are rejected under 35 U.S.C. § 102(e) as being anticipated by Shankar et al (U.S. Publication No. 2004/0167132).

Specifically, the Examiner contends that Shankar et al. teach pharmaceutical compositions comprising EDG-2 antagonists for the treatment of diseases such as asthma.

This rejection has been overcome by incorporating the recitations of non-rejected claims 18 and 20 into claim 9. Accordingly, removal of the rejection is requested, respectfully.

2. At pages 8-10, claims 9 and 20 are rejected under 35 U.S.C. §102(e) as being anticipated by Dahnke et al (WO 2003/101978).

Specifically, the Examiner contends that Dahnke et al. teach a compound within the scope of formula (III) for treatment of chronic diseases such as osteoporosis.

This rejection has been overcome by amending claim 9 to distinguish over Dahnke et al. by reciting that E^c is benzene optionally having substituent(s), piperidine optionally having substituent(s), isoxazole optionally having substituent(s), pyrazole optionally having substituent(s), pyridine optionally having substituent(s), thiazole optionally having substituent(s), imidazole optionally having substituent(s), pyrrole optionally having substituent(s), or

pyrrolidine optionally having substituent(s) and that G^c is a bond. Accordingly, removal of the rejection is requested, respectfully.

C. Double Patenting

1. At pages 10-11 of the Office Action, the Examiner provisionally rejects claims 7, 9, 12, 14, 15 18 and 20 on the grounds of non-statutory obviousness-type double patenting, as being unpatentable over claims 1-16 of copending Application No. 10/515,653.

Since no allowable subject matter has been identified in either application, the Examiner is requested to hold this rejection in abeyance.

2. At pages 11 and 12 of the Office Action, claims 7, 9, 14, 15 and 20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-80 of copending Application No. 10/530,249.

Since no allowable subject matter has been identified in either application, the Examiner is requested to hold this rejection in abeyance.

3. At page 12 of the Office Action, claim 7 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 9-24 of copending Application No. 10/483,815.

This rejection has been rendered moot by the amendments to claim 7 incorporating the compounds of formulas (I) or (III).

4. At page 13 of the of the Office Action, claims 7, 10, 11 and 15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 8, 10-12, and 24-34 of copending Application No. 10/467,359.

This rejection has been rendered moot by the amendments to claim 7 incorporating the compounds of formulas (I) or (III).

5. At page 13 of the Office Action, claims 7, 10, and 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/477,106, now USP 7,179,817.

This rejection is overcome by the Terminal Disclaimer submitted herewith,

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No.: 10/519,106

Atty. Docket No.: Q85523

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

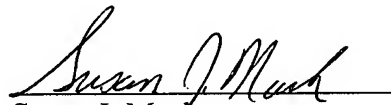
Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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CUSTOMER NUMBER


Susan J. Mack
Registration No. 30,951

Date: April 17, 2007